

REQUEST FOR RECONSIDERATION AND SUMMARY OF PERSONAL INTERVIEW WITH
THE EXAMINER
Ser No. 10/666,573

September 26, 2006

REMARKS

Summary of Personal Interview With the Examiner

On August 28, 2006, Examiner Irina Zemel and the Applicants' representative, Andrew Merriam, conducted a personal interview to further prosecution in the instant application. The Applicants wish to thank Examiner Zemel for extending the courtesy of a personal interview.

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During the interview, the parties discussed the scope of enablement rejections and Mr. Merriam explained that the instant Applicants have invented improved intumescent coatings wherein the coating compositions comprise a thermoplastic as well as thermosetting binder and the thermoplastic binder reacts in to the composition upon intumescence. See instant claim 1, for example. Mr. Merriam explained that the instantly recited thermoplastic binder can be any conventional thermoplastic binder that reacts with the instantly recited phosphoric acid, as instantly recited; likewise, the thermosetting binder can be any conventional thermosetting binder that reacts with the instantly recited phosphoric acid, as instantly recited. See, for example, the instant specification at page 4, lines 25-30 and page 2, 2nd, 3rd, 4th, 5th, 6th, 7th and 8th paragraphs. Further, Mr. Merriam pointed out that the enablement rejection cited only one In re Wands factor, claim breadth, in support of the rejection; and it is not proper to make any enablement rejection on the basis of a single In re Wands factor. MPEP 2164.01, 3rd paragraph.

No agreement was reached regarding the rejection.

The Examiner requested entry of the official translation of Hoechst on the record by Applicants.

The Examiner graciously agreed to consider the remarks in this response and indicated her willingness to speak again with Mr. Merriam by telephone to further prosecution in the instant application.

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The Amendment to the Instant Claims

Each of instant claims 2, 5, 8 and 17 has been amended solely in adopting a suggestion of the Examiner, and to insure consistency in antecedent basis. Upon entry of the present amendment, claims 1-6, 8-14 and 17-18 will stand pending in the instant application. No new matter is added by the present amendment.

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Rejections Under 35 USC §112, First Paragraph

Claims 1-6, 8-14 and 17-18 stand rejected under 35 U.S.C. 112, first paragraph as lacking enablement for powder or aqueous coating compositions comprising thermosetting binders other than epoxy or hydroxylated binders, curing agents other than phenolic curing agents, and thermoplastic binders other than oxygenated heterocyclic thermoplastic binders. The Applicants respectfully traverse these rejections.

The rejection alleges that the instant invention is broadly claimed and, second, that the instant specification provides no guidance on how to choose the thermosetting binders, curing agents and thermoplastic binders "outside of the expressly disclosed examples". The first allegation alone is inadequate to support a proper enablement rejection. Regarding the first allegation, contrary to the position taken in the rejection, an allegation that the instant claims are too broad will not support an enablement rejection. For any enablement rejection to be proper, the ordinary skilled artisan must be unable to practice the instantly recited invention without undue experimentation. MPEP 2164.01, 3rd paragraph. The second allegation is patently false because the instant specification directs the ordinary skilled artisan as to how to select binders and curing agents where such selection is not already known and predictable.

The factors useful in determining whether a disclosure does not satisfy the enablement requirement include, but are not limited to the factors set forth in In re Wands, 858 F.2d at 736-740. The rejection fails to consider more than one of these factors (claim breadth). Evaluating these factors:

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The "nature of the invention", i.e. the subject matter to which the claimed invention pertains, is intumescent powder and aqueous coatings. MPEP 2164.05. Applicants did not invent intumescent coatings or compositions and do not attempt to claim they did so. See, for example, the instant specification at page 1, 4th full paragraph to the end of page 2 and at the last paragraph of page 2.

The nature of the instant invention involves novel and useful combinations of known intumescent ingredients combined with reactive thermoplastic binders. Essentially, the carbonific and blowing agent of conventional intumescent coatings have been replaced by a binder system that effectively contains active groups similar to the traditional active materials, pentaerythritol and melamine. See, for example, the instant specification at page 4, lines 25-30 and page 2, 2nd, 3rd, 4th, 5th, 6th, 7th and 8th paragraphs.

Further, "the state of the prior art", i.e. what one skilled in the art would have known, includes known conventional ways to, make, mix, apply and cure powder and aqueous coating compositions, which have been available commercially for years. See, for example, the instant specification at the last 2 lines of page 1, and at page 6, lines 16-20 (explaining processing to make a coating powder). Thus, the nature of the invention is a novel and unobvious improvement to known intumescent coating compositions.

Still further, the level of skill in the art in relation to the subject matter to which the claimed invention pertains includes extensive knowledge of intumescence, and the knowledge of how to make and use powder coatings and aqueous coatings. This knowledge includes the knowledge of curing agents useful to cure the thermosetting binders disclosed and directed by the instant specification.

Yet still further, and contrary to the position taken in the rejection, the instant specification provides ample guidance or direction as to how to select each of the thermosetting and thermoplastic binders useful in the instantly recited invention; and, the instant specification provides examples of the thermosetting and thermoplastic binders by setting forth conventional thermosetting binders as well groups on each of thermosetting and thermoplastic binders that react with

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phosphoric acid. See, for example, the instant specification at page 2, last paragraph, page 3, lines 10-18, page 4, lines 25-30, page 5, , lines 4-9 and 11-17. Further, the critical amounts of each kind of binder and the balance therebetween are taught, and claimed for creating the intumescent compositions of the instant claims. See, for example, the instant specification at page 6, 1st full paragraph and last 6 lines.

Yet even still further, there are also 6 working examples in the instant specification at pages 7 and 8.

Regarding predictability in the art, contrary to the position taken in the rejection, the art of intumescence is well explained and the reactive nature of the instantly recited thermosetting and thermoplastic binders is readily predictable based on the teachings of the instant specification. Further, and contrary to the position taken in the rejection, it is highly predictable given the teachings of the instant specification that thermosetting binders and the known curing agents for such resins will react with each other.

Finally, the instant claims are limited in their scope to specific critical weight ratios of thermosetting and thermoplastic binders, and the binders themselves must react with phosphoric acid. This claim scope is limited to intumescent compositions. As is proper, that which is well known is left out of the instant specification. Thus, the instant claims are not overly broad and are limited to reasonably well disclosed and critically useful combinations, such that the ordinary skilled artisan can readily make and/or use them.

The rejections are improper and Applicants respectfully request the reconsideration and the withdrawal of all enablement rejections.

Rejections Under 35 USC §112, Second Paragraph

Claims 2, 5, 8 and 17 stand rejected under 35 U.S.C. 112, second paragraph, as lacking proper antecedent basis.

While literal antecedent basis is not required by law, Applicants have amended the instantly rejected claims and have thereby rendered all antecedent basis questions moot.

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For all of these reasons, the Applicants respectfully request the
reconsideration and the withdrawal of all rejections.

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CONCLUSION

Based on the foregoing, the instant claims are believed to be in current condition for allowance. An early and favorable response is earnestly solicited. If the examiner has any questions problems concerning the instant application, (s)he is urged to contact the undersigned at the number given below.

No fees are believed due. In the event that any fees are found owing, please charge deposit account no. 18-1850.

Respectfully, submitted



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